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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/570,151	03/01/2006	Hiroshi Nakatani	071850	8047
38834 7590 02/04/2010 WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP 1250 CONNECTICUT AVENUE, NW SUITE 700 WASHINGTON, DC 20036				
EXAMINER				
VAJDA, PETER L				
ART UNIT		PAPER NUMBER		
1795				
NOTIFICATION DATE		DELIVERY MODE		
02/04/2010		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentmail@whda.com

Office Action Summary

Application No.

10/570,151

Applicant(s)

NAKATANI, HIROSHI

Examiner

PETER L. VAJDA

Art Unit

1795

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 November 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SG-08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Interval Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

The applicant's reply and Rule 1.132 Declaration filed 11/18/2009 have been received. The Declaration has been considered, but is not found to be sufficient to overcome the pending rejection for reasons outlined below. Claims 1 and 3-17 remain pending.

Claim Rejections - 35 USC § 112

Claims 1 and 3-17 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The applicant has amended pending claim 1 to further define the silica fine particle (A) as being nonconductive. However, the specification nowhere teaches that the silica particles be nonconductive nor are any conductivity or resistance values for the silica fine particles taught. The submission of a resistivity of a silica material is not sufficient to show that all silica particles are nonconductive. If the applicant submits evidence in a signed declaration disclosing the resistivity of the silica particle used by the applicant, then that resistivity may be recited in the pending claims, but it is not sufficient to show a resistance value of one silica powder and claim that all silica powders are nonconductive or to claim possession of all nonconductive silica powders.

Response to Amendment

The declaration under 37 CFR 1.132 filed 11/18/2009 is insufficient to overcome the rejection of claims 1 and 3-17 based upon 35 U.S.C. 112, first paragraph, as set forth in the last Office action because: the declaration does not show the conductivity values of the silica particles used in the applicant's specification. The applicant has submitted a reference with the declaration that states that crystalline silicon oxide particles have a resistivity of 1×10^{21} ohm*m and then argued that a skilled artisan would have readily ascertained that the silica particle of claim 1 is a silica particle inherently being non-conductive. The applicant has not shown that the silica particles recited in the specification have said resistivity nor has the applicant shown conductivity/resistivity measurements involving the silica materials used in the inventive embodiments. Additionally, the translation of the Japanese reference reciting the resistivity of crystalline silicon dioxide states that the resistivity is 1×10^{21} ohm*m, while the applicant states in their declaration that the resistivity of 1×10^{13} ohm*m. The copy of the reference is not legible, specifically with regard to the resistivity value being cited and the examiner cannot ascertain which value is correct. The applicant further argues that one skilled in the art would have recognized that the silica particles were non-conductive because the applicant discusses the effect of the resistive properties on the toner. However, no mention is made of resistivity or conductivity of the silica particles and then discussion of conductivity properties for the conductive inorganic fine particles does not speak to the conductivity of the silica particles. Therefore, since the applicant

has not shown the conductivity or resistivity of the actual particles recited in the application and since the copy of the Japanese reference submitted by the applicant is illegible, the Rule 1.132 Declaration is not found to be persuasive to overcome the 35 U.S.C. 112, first paragraph, rejection cited above.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to PETER L. VAJDA whose telephone number is (571)272-7150. The examiner can normally be reached on 7:00AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Huff can be reached on 571-272-1385. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Mark F. Huff/
Supervisory Patent Examiner, Art Unit 1795

/PLV/ 1/29/2010